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IN THE

Supreme Court of the United States

OCTOBER TERM, 1950.

No. 341.

FORREST H. SMITH ET AL., *Petitioners,*

v.

FLORENCE-MAYO NUWAY COMPANY ET AL., *Respondents.*

BRIEF FOR RESPONDENTS IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI.

There are no grounds stated in the Petition herein, or in the Petitioners' brief, that establish any basis for bringing this case within the provisions of the rules of this Court.

This is an ordinary patent case, involving only the issue of infringement, which has been decided by the District Court below, and which has been reviewed and unanimously affirmed by the Court of Appeals for the Fourth Circuit (182 F. (2d), 507; Petitioners' App., 24).

The patent in suit has not been litigated in any other circuit, so that there are no conflicting decisions of any courts of appeal.

The only ground advanced in support of the petition is the allegation that the ruling of the Court of Appeals for the Fourth Circuit "is contrary to the ruling of this Court in *Graver* v. *Linde*, 339 U. S., 605" (Petition p. 2 and Brief, p. 12). As will be shown, there is absolutely no basis for any such allegation.

What the petition in this case is *really* requesting is a reconsideration by this Court of the issue of infringement, which has been decided adversely to petitioners in both the District Court and Court of Appeals below, and which neither requires nor warrants any further consideration.

The present case is based on the *same* patent (No. 2,051,348, Smith) as was involved in the case of *Forrest H. Smith et al.* v. *General Foundry and Machine Co., et al.*, in which a Petition for Certiorari was brought before this Court at the October Term, 1949, (No. 325) by the *same* Petitioners. In that case, the issue of infringement had likewise been decided adversely to petitioners by both the District Court and the Court of Appeals for the Fourth Circuit, and the Petition for Certiorari was accordingly *denied*. It is urged that it should be similarly denied in the present case.

In amplification of Petitioner's reference, on page 2, to the decision of the Court of Appeals affirming the decision of the District Court, attention is directed to the following quotations from said decision:

> "We do not think it necessary to pass upon the validity of the claims in suit, for when they are limited, as they (fol. 11) must be, by the prior art, they are clearly not infringed by the devices of the defendants. This is perfectly clear as to claim 2, which calls for *a screen which defendants do not use;* and we think it equally clear as to the other claims. In claim 1, the requirement is that the *independent* fuel burning units be *'arranged in series adjacent the walls'* of the tobacco barn; and in claim 7, as in claim 2, there is a requirement that the *heating units* be *'arranged in series extending substantially around and adjacent the walls'* ". (Italics ours.)

In an earlier part of its decision the Court of Appeals, in applying the prior art, stated:

> "The record in this case clearly shows that there was nothing new in the use of open flame oil burners for heating tobacco barns. Brock Patent No. 1,368,018 discloses as heating means of tobacco barns, long perforated bunsen burner type heaters covered by an adjustable hood. Reynolds Patent No. 1,509,902 shows the use of an open flame burner under a hood. Other prior art patents of which notice should be taken are the Mims Patent No. 1,493,889, showing the use of an open flame oil burner covered by a hood for treating vegetables and Fizer Patent No. 265,051, showing a number of heaters, but without oil burners, arranged along the walls of a tobacco barn. Account must be taken also of the Torrid Stove installation, which consisted of independent oil burning stoves used for heating purposes in tobacco barns and of the teaching of Agricultural department bulletins as to the use of open flame burners in series for the production of gases for the coloring of oranges and grapefruit.
>
> In the light of this prior art it is idle to contend, as does appellee, that the claims in suit should be so broadly construed as to give the patentee a monopoly on the use of open flame burners in the curing of tobacco."

Errors and Inaccuracies in the Petition and Brief.

It is not seen wherein the decision of the Court of Appeals for the Fourth Circuit in the case of *Florence-Mayo Nuway Co.* v. *Hardy, et al.*, 168 F. 2d 778, (C. C. A. 4) is pertinent to the issue here under consideration. However, since the decision has been brought into the Petition and Brief, reply is here made particularly for the purpose of correcting errors and inaccuracies in said Petition and Brief.

On page 4 of the petition, it is stated that the "Court of Appeals for the Fourth Circuit found the Mayo patent valid on the ground that Mayo was the first to solve the problem of open flame curing of tobacco".

But the opinion (168 F. (2d) 778) says that

> "There is nothing in the prior art which anticipates the combination (claimed). What was new was the combination of these (old elements) *with a device for delivering the outside air under the hood and over the burners*, . . . such a combination was nowhere shown in the prior art". (Italics ours.)

Also:

> "Defendants' infringing device adopted the heart of the Mayo invention".

Moreover, the Court observed (Petition, p. 6) that the Mayo patent was held

> "valid and infringed against the device of Hardy, which was a mere Chinese copy"—

In other words, this was merely a case of a specifically new idea covered by a valid patent, and held infringed by an *identical* device. The court held it was not a pioneer patent.

Similarly, the Smith patent here in suit is not a pioneer patent, and must likewise be "limited to the exact combination which it discloses". It may be infringed by any one using this "exact combination", but the Court of Appeals held that the accused structure of respondents is decidedly different and "does not infringe the claims of the patent". (Petitioners' App. p. 29.)

Thus there is nothing inconsistent in the ruling of the Court of Appeals in the two cases.

On page 5 of the petition, reference is made to comments of the Court of Appeals on the "deception that had been practiced in the Mayo-Hardy case". This is a misstatement. The observation made by the Court was that it "was misled by the undisputed evidence in the record into believing that Mayo was . . . the first to achieve commercial success". (Petition, p. 6)

At the bottom of page 3 of the petition, reference is made to Smith's "alternate arrangement" in which a "common hood is provided for several aligned burners" (as distinguished from a separate hood for each burner), and the statement is made (top p. 4) that after Smith got started "The Defendant Mayo brought out *his* apparatus employing the alternate arrangement described in the Smith patent". This infers that Mayo copied Smith's "alternate arrangement", but the fact is Mayo began to manufacture his accused heating units in 1935, (Appellants' Appendix, p. 29) *before* the Smith patent issued (August 1936). Not only was Mayo selling his improved heating units before Smith's patent issued, but he was making and selling them *before Smith ever offered to the public his so-called alternate arrangement.* This alternate arrangement was first offered as "Model D", shown in Smith's descriptive circular "Appellants' Exhibit I" (Appellants' App. p. 129). The record is silent as to the date of this circular, but it bears on its face the number of the Smith patent, so it could not have been published until after August, 1936, the date of issuance of this patent.

At the bottom of page 6 of the Petition it is stated that the same prior patents, including Mims, were before the court in both the *Mayo-Hardy* case and the present case. This is an error. The important patent to Mims was *not* before the court in the *Mayo-Hardy* case. Nor were the various publications and prior uses, which influenced the Court of Appeals in the present case. (182 F. 2d, 507.)

At the top of page 7 of the petition, there is no basis in the record for "high-pressure burners", and such a designation is unwarranted.

On pages 12 and 15 of the brief it is asserted that the "prior patents presented in support of the defense of invalidity are the same as those fully considered by the Patent Office in granting the patent". This again is an error. The Patent Office did *not* consider the important patent to Mims. Neither did it have before it the Agriculture Dept.

Bulletins and prior use of the "Torrid" oil-burning heater on which the present defense was based.

On page 15 of the brief, reference is made to the "paper" patents of Mims, Reynolds and Brock. This too, is misleading. The Reynolds patent was *far* from being a mere "paper" one. The Reynolds curer had been quite widely used in actual practice and had operated successfully. Note particularly the deposition of Moss, beginning at p. 108 (Appellants' Appendix). This witness said that he had made "two or three curings" with the Reynolds equipment (p. 110); that there were "some used in the eastern part of the state" (p. 111); that the Reynolds "would yellow the tobacco alright"; and if he had had "additional capacity of the same kind" it would have cured the tobacco "through to completion" (p. 115, 116).

Note also the deposition of S. B. Mercer (pp. 105-106). This witness says that, although somewhat expensive, he "*did* cure three barns with the Reynolds".

Finally, in the "Conclusion" on page 17 of the brief it is again asserted that "the same prior art was cited in both" the Mayo-Hardy and the present case. It must be *again* pointed out that neither the Mims patent nor the publications and prior uses discussed by the Court of Appeals here were in evidence in the Mayo-Hardy case.

Reply to Petitioners' Argument.

In many places throughout the petition and brief reference is made to the exact character of the "Smith commercial installations".

It is submitted that the character of these installations is *wholly immaterial*. The *sole* question here presented is that of the interpretation and alleged infringement of the *claims* of the patent, and a consideration of Smith's commercial installations cannot possibly throw any light on this question.

> "The claim is a statutory requirement, prescribed for the very purpose of making the patentee define pre-

cisely what his invention is; and it is unjust to the public, as well as an evasion of the law, to construe it in a manner different from the plain import of its terms." (*White* v. *Dunbar*, 119 U. S., 47).

"The claims measure the invention. They may be explained and illustrated by the description, but they cannot be enlarged by it". (*Continental Paper Bag Co.* v. *Eastern Paper Bag Co.*, 210 U. S., 405).

I.

The brief (pp. 14, 15) stresses that the Smith and Mayo actual installations function in a similar manner, and produce the same result or accomplish the same general purpose, and argues that therefore they must be patentably the same. But this argument is not supported by the law.

> "Any one may lawfully accomplish the same end without infringing the patent, if he uses means substantially different from those described". (*O'Reilly et al.* v. *Samuel Morse et al.*, 56 U. S., 62-[119])
>
> "The argument used to show infringement assumes that every combination of devices in a machine which is used to produce the *same effect* is necessarily an equivalent for any other combination used for the same *purpose*. This is a *flagrant* abuse of the term 'equivalent' ". (*Boyden Power Brake Co.* v. *Westinghouse*, 170 U. S., 537.) (Italics ours.)
>
> "But, after all, even if the patent for a machine be a pioneer, the alleged infringer must have done something more than reach the same result. He must have reached it by substantially the same or similar means" (Id.).
>
> "That two machines produce the *same effect will not justify* the assertion that they are substantially the same, or that the devices used by one are therefore mere equivalents for those of the other". (*Burr* v. *Duryee*, 68 U. S., 531 [572]) (Italics ours.)

Incidentally, it may be pointed out that there is no reference whatever in the Smith patent to any alleged "blanket of heat" (p. 14) or to "blanket the walls with hot gases" (p. 15). This idea originated in the active imagination of plaintiff's expert.

II.

It cannot be seen that the ruling of the Court of Appeals is in any way inconsistent with or contrary to the decision of this Court on which Petitioners rely, namely *Graver Tank & Mfg. Co.* v. *Linde Air Products Co.* (339 U. S., 605). This decision merely re-affirms the well known doctrine of equivalents which, as stated in the opinion itself, has been recognized for "almost a century". As the Court says, it is "available for utilization when the proper circumstances for its application arise". Also:

> "What constitutes equivalency must be determined against the context of the patent, the prior art, and the particular circumstances of the case".

Furthermore, the Court in this case was careful to point out:

> "The wholesome realism of this doctrine is not always applied in favor of a patentee but is sometimes used against him. Thus, where a device is so far changed in principle from a patented article that it performs the same or a similar function in a substantially different way, but nevertheless falls within the literal words of the claim, the doctrine of equivalents may be used to restrict the claim and defeat the patentee's action for infringement. Westinghouse v. Boyden Power Brake Co., 170 U. S. 537, 568."

Consequently, in view of the construction and manner of operation of the Mayo device paralleled with the essential limitations of the claims of the Smith patent, as stressed in the Court of Appeals' decision, if the *Graver Tank* case is applicable, it would have to be used against the patentee, instead of for him.

III.

It is submitted, the doctrine of equivalents is *not applicable* to the case at bar. The question of infringement of the Smith claims does not depend for its answer on the doc-

trine of equivalents, but rather on the elementary principles of interpretation of the claims in the light of the file history.

(a) "Adjacent."

As to the limitation "adjacent the walls of the barn" which Petitioners so particularly stress, attention is called to the language used in claim 1. This claim calls for a drying house having "side walls and end walls" and a plurality of burners "arranged in series adjacent the walls (*all four walls*) thereof". This is clearly shown in Fig. 1 of the Smith patent drawing.

A typical installation of respondents is shown in the Florence-Mayo descriptive circular "Appellants' Exhibit N" (Appellants' App. p. 137). This installation comprises four units arranged one near each corner of the barn. In the first place, *two* things only cannot be said to constitute a "series", so the only "series" present in respondents' installation is the series of burners contained in each unit. But these series of burners are disposed parallel with *two* walls of the barn only, namely the two opposite side walls, and not all four walls as shown and claimed by Smith. In the second place, these two series of burners are located 3½ feet from the walls with which they are parallel, and seven feet apart, i.e., 3½ feet from the center of the barn. Thus the series of burners are the *same distance* from the walls as they are from the center of the barn, and are no more "adjacent the walls" than they are adjacent the center of the barn.

In sharp contrast to this, the Smith patent (p. 2, line 30), refers to his units as "wall burners", and shows them in Fig. 1 as *closely* adjacent all four walls. The two ideas are wholly and fundamentally different.

(b) "Independent."

Claim 1 requires the burners constituting the series to be "independent".

The word "independent" does not occur in the Smith specification, and it is necessary to examine the file history to gain any light on what it is intended to mean.

This file history (Defendants' Exhibit 17) shows that claims 1 and 2 were first rejected as "not patentably distinguishing" from the claims of the first Smith patent No. 1,811,980 (Appellants' App., p. 207), now expired. Smith's solicitor then inserted by amendment the word "independent" (p. 42 of file), and argued (p. 43) that the claims of the prior patent include " 'a substantially horizontal flue extending adjacent to and inside the walls', and not a plurality of spaced, independent units, as called for" by the present claims.

On this argument, claims 1 and 2 were then allowed.

It will be apparent by reference to Fig. 1 of the first Smith patent (Appellants' App., p. 201) that it discloses every single element of claim 1 here in suit, if the word "independent" be omitted. It clearly contains a "plurality of spaced, fuel burning heating units located within the house and arranged in series adjacent the walls thereof" *exactly the same* as the Smith patent here in suit. Furthermore, the products of combustion in this first patent are discharged into the barn through the adjustable dampers 13 above the burners, just as they are discharged in the patent in suit. But the products of combustion from these "spaced heating units" in the prior patent *first enter a common conduit,* namely the flue 8, and are then discharged. Claims 1 and 2 of the patent here in suit were allowed, over the prior Smith patent, on the theory that they distinguished therefrom by calling for heating units which are "independent" of each other, that is to say, each unit is an *individual, separate* device, with its own hood, or baffle, as shown in Figs. 1 and 2 of the Smith patent in suit (Appellants' App., p. 120).

With such an arrangement of burners, each functions separately to generate its own rising column of combustion gases. It is therefore clear that claim 1, limited as it is

to "independent" burners, specifically defines the arrangement of Figs. 1 and 2 of Smith, the so-called "preferred form". There is *nothing* in the Smith patent or file history to indicate that claim 1 applies, or was ever intended to apply to the so-called "alternate arrangement", namely that shown in Figs. 12 to 14, and described in lines 22 to 32, column 1, p. 3 of the Smith specification. Obviously claim 1 does *not* apply to this "alternate arrangement", because in it a plurality of burners or heating units are disposed under a common hood or conduit, just as in the first Smith patent (now expired), and hence are *not* "independent", within the meaning of the claim.

> "Where the actual invention, described in the specification, is larger than the claims of the patent, patentee, in suit for infringement, is limited to what is specified in the claims". (*Bates* v. *Coe*, 98 U. S. 38).
>
> "When his application was rejected by the Patent Office, . . . the applicant, without objection or appeal, amended his claim" . . .
>
> "Having thus narrowed his claim . . . in order to obtain a patent, the patentee may not by construction, or by resort to the doctrine of equivalents, give to the claim the larger scope which it might have had without the amendments". (*Weber Elec. Co.* v. *Freeman Elec. Co.*, 256 U. S., 668)
>
> "The patentee, having . . . made it an element of these two claims, is not now at liberty to say that it is immaterial, or that a device which dispenses with it is an infringement, though it accomplish the same purpose, in, perhaps, an equally effective manner".
>
> "The novelty of the invention is at least open to doubt, and we think the patentee should be held to a rigid construction of these claims". (*Wright* v. *Yuengling*, 155 U. S., 47.)

Respondents' structure is not like Fig. 1 of Smith. In Respondents' structure there are a plurality of spaced "heating units" disposed *under a common hood*, like the "alternate arrangement" shown in Figs. 12 to 14 of Smith. The products of combustion from all of these burners first

enter this common hood or horizontal conduit, which serves as a mixing chamber, and the mixed gases are then discharged, the *same as in the expired Smith patent.* In this patent the products of combustion first enter and are mingled in a common flue or horizontal conduit, and are then discharged. Thus the units in Respondents' structure are not "independent", within the meaning which must be given to this word, particularly in view of the file history of the Smith patent in suit. Respondents do not employ the one feature which was asserted to render the claims of the patent in suit patentable over the prior Smith patent, and hence they do not infringe.

(c) Claims 2 and 7.

Claims 2 and 7 are more specific than claim 1. They require the series of burners to extend "substantially around and adjacent the walls". This obviously means *all four* walls, and as pointed out above, Respondents' burners are not so arranged.

Moreover, claim 2 definitely recites an element which, admittedly, Respondents do not employ, namely, "a screen". For these two reasons the Court of Appeals held this claim not infringed.

The same is true of claim 7, as to the first reason, and, moreover, claim 7, in its last few lines, recites a structure not used at all by Respondents.

> "In such a (combination) claim, if the patentee, specifies any element as entering into the combination, . . . he makes such element material to the combination, and the court cannot declare it to be immaterial" (*Fay* v. *Cordesman*, 109 U. S., 408).

CONCLUSION.

1. The decision of the Court of Appeals is in no way inconsistent with or contrary to the ruling of this Court in *Graver Tank & Mfg. Co.* v. *Linde Air Products Co.*, or any other case;

2. The doctrine of equivalents is not applicable to the case at bar;

3. The prior art cited in the present case was much more comprehensive than that cited in the Mayo-Hardy case, and influenced the Court of Appeals to hold that neither Smith nor Mayo were pioneers, but that the patents of both were mere improvement patents and must be limited to the exact combinations disclosed;

4. Claim 1 of Smith is limited by the plain import of its language and definitely by its file history to an arrangement which is wholly different from that used by Respondents;

5. Claims 2 and 7 specifically include, in their combination, elements which Respondents do not employ;

6. Therefore, the ruling of the Court of Appeals that these claims are not infringed is fully warranted, and should not be disturbed.

It is respectfully submitted that the petition fails to advance any proper ground for granting a writ of certiorari in this case, and particularly fails to show any conflict of opinion among the several Courts of Appeal, or any error herein by the Court of Appeals for the Fourth Circuit, and it is urged that the petition should be denied.

Respectfully,

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